

## **REMARKS**

In the Office Action of 16 May 2004, the Examiner withdraws his objections over Patent 6,258,200 issued to Kassab, over Patent 5,403,025 issued to Shanley and over Patent 5,334,431 issued to Longtin

However, as stated in item 7, the Examiner rejects claims 24-29 and 330-40 under 35 USC 102(b) as being anticipated by Su.

In item 9, the Examiner also rejects claims 1-10, 13-17, 19, 24-29 and 31-41 under 35 USC 103 (a) as being unpatentable over Su( Patent 5,462,782)

In item 10, the Examiner further rejects claims 11-12,18 and 30 under USC 102 (b) as being unpatentable over Su in view of GB 1,005,155

The applicant thanks the examiner for withdrawing his objections based on the Kassab, Shanley and Longtin references.

The applicant respectfully disagrees with the Examiner's rejection of :

- (Item 7, page 3) claims 24-29 and 33-40 under USC 102(b) as anticipated by Su
- (Item 9, page 4) claims 1-10, 13-17, 19, 24-29 and 31-41 due to Su (5,462,782) and
- (Item 10, page 5)claims 11-12, 18 and 30 due to Su in view of GB 1,005,155

and believes these are in condition for allowance for the reasons discussed below.

**Summary :**

The applicants' arguments below are based, *inter alia*, on fundamental differences between the Su solution and the present application. These include:

- that the Su display mount is made of multiple plastic materials, laminated, the principal one of which is a hard plastic plate. The present application refers to a single, soft material.
- size : the Su plate assembly can not be smaller than the sheet object it is designed to flatten, then carry to a glazy surface, attaching the whole thereto. The present application defines a mount size much smaller than the sheet object.
- plurality: by definition, the Su invention is used at the rate of one hard plate assembly per sheet object and it would be impossible to use a multiplicity. The Su invention would therefore never be concerned with a plurality, whereas the present application refers to the use of a plurality of mounts.

That is, Su uses familiar materials in a novel way and the current application uses similar familiar materials in a novel way – a way which is different from Su.

Additionally, the applicant respectfully points out that a number of the claims presently rejected draw their dependence from the main claims and seek only to refine these. That is, for example, the present application makes no claims concerning the art or invention of the materials used but, rather only as to their use in a novel application.

**Item 7.**

**Rejection of Claims 24-29 and 33-40**

under 35 USC 102 (b) as being anticipated by Su.

The applicant recalls the fundamental differences between Su and the present application with regard to the structure, scope and intention of these different inventions.

Both inventors build their ideas on the known "cling" properties of suitably softened PVC, and on the use of adhesives, with the associated protective layers. But the similarities stop there.

With respect, the applicant does not believe that the mere common use of well-known cling and adhesive properties constitutes any awareness in Su of the kind of idea offered by the applicant. The solutions are related only in that they display, in some way, sheet objects.

Su teaches a multi-layered structure, based around a hard (stiff) plastic plate layer, which is intended to act as a "plate assembly to which a sheet object, such as a propaganda, advertisement or photograph can be adhered".

Su therefore creates a stiff, flat plate which is designed to flatten the sheet adhered to it. Importantly, he teaches adhering the sheet to the plate and does not teach of a tool, as the present application claims, which is adhered to sheet material much larger than itself.

That is, in Su, the sheet object to be displayed is the same size as, or smaller than, the invented plate assembly, whereas the present application creates small label-like tools to affix to a sheet many times their size. Nor is the size difference simply a matter of degree or of claimed size; Su's flat plate assembly MUST be at least as large as the sheet it fixes, whereas the present mount should be as small as practicable, to be affixed as inconspicuously as possible, to a fraction of the face of the sheet to be mounted.

Claims 24 –29 relate, it is submitted, to the intrinsic difference in the intentions of the two inventors as to the tasks to be undertaken. The most basic difference is the physical fact that Su teaches a laminate based on his hard plate "adhesive layer". Su's invention can in no way claim to be, as claimed in 24 and 25, "made of a single material". Su has thus no call over claims 24 and 25 in particular, due to the complexity of his laminate invention.

With regard to the further reasons, given in the Examiner's item 7, for rejection of these claims, the applicant would respectfully point out that it is the present application and not Su which makes and can make the claims cited therein.

That is, nowhere does Su refer to "a mount", but uses the term "an assembly". It is an assembly upon which may be mounted sheet objects.

Nor does he refer to "...capable of adhering the mount only to a part of one surface of a sheet". Su never claims, as is said in item 7, that "the entire surface of the mount is adhered to less than half the surface of the sheet". His invention absolutely would not work were this to be the way it was employed.

This is part of the essential differences mentioned earlier and is a valid reason, the applicant submits, for the inclusion, in the present application, of the differentiating claims which draw their dependencies from claim 1 and refer, for example, to the invention being "capable of adhering the mount only to a part of a surface of a sheet..". Su's invention must be at least as big as the sheet object for it to achieve his first stated intention – to flatten the sheet on to the assembly.

With reference to the Examiner's view of the phrase "capable of", the applicant submits that the expression, (which should properly be taken as "...capable of adhering the mount only to a part...") is in fact, as intended, a proper limiting statement with regard to the size of the mount in relation to the sheet to which it is being adhered. The claim differentiates the invention from Su which teaches an assembly at least as large as the sheet object.

**Item 9**

**Rejection of claims 1-10, 13-7, 19, 24-29 and 31-41**

under 35 USC 103 (a) as being unpatentable over Su

The applicant respectfully disagrees with the Examiner's rejection of **claims 1-10**.

In Patent 5,462,782, Su creates the "cling" properties of his plate by adhering soft PVC to the hard plate as an additional layer. In the present application, the soft "cling" PVC, with adhesive on one side, is *the entire structure*. The Su flat plate seeks to use the plate to flatten the sheet, whereas in the present invention, the glass window or other glazy surface against which the sheet is hung, does the flattening.

In the present application, all claims relate to a single soft plastic material plus its protective layer. Never to any multiple-material plate assembly. The intentions of the two inventions, the applicant submits, are different.

Su's invention would not accomplish the intentions of the present invention and vice versa.

Suppose the task to be the mounting of a paper poster in a window:-

A plurality of the present mount are adhered, by their adhesive-coated side, to the face of the sheet, usually one on each corner. The sheet can then be adhered and spread flat by pressing the mounts to "cling" to the window, so that the poster sheet is viewed directly through the glass - as is normal.

With the Su invention, the poster is adhered to the adhesive-coated side of the flat plate, with its back to the flat plate assembly, "without a back glue". The Assembly, carrying the sheet, is then attached to a glazy surface by the soft PVC layer on its back. Thus the photograph or notice is intended to be displayed on the front of the plate assembly, on the front face of the glazy surface and the assembly will not be appropriate for the inside of a shop window, with the image showing through the glass.

On the other hand, as above, the present invention will not serve to flatten the sheet (Su's first aim) other than by pressing and holding it against the glass.

Reference has been made by the Examiner to the supposition that Su would have understood how to create a plurality of mounts. The applicant readily agrees this manufacturing skill can be assumed but would submit that, whereas the present

invention is intended to be supplied and used as a plurality to attach a sheet object larger than itself, Su's plate is the same size as, or larger than, the sheet and he would envisage only one plate assembly being used per sheet.

The relevant claims in the present application do not claim the art of creating a plurality of mounts but draw dependence ultimately from claim 1, which they amplify.

Addressing Item 9, paragraph 3 on page 4, it is accepted that it is not unusual for a product like the Mount referred to in the present application to be produced on rolls. The reference to presentation on a roll is a dependency of the main claim and defines how these particular mounts may be provided. (Su would be unable to provide his invention on a roll, as a major feature of his assembly is that it is based on a comparatively large hard flat plate.)

The applicant believes that the above arguments also answer the Examiner's comments in item 9, paragraph 4 on page 4 concerning the thickness and size claims in the present application. It has been shown that the difference in size between the present invention and Su is important and reflects the different intentions of the inventors.

It is indeed true that, by experimentation or accident, Su might well have arrived at the idea of using small hard plate multiple material cling mount assemblies of the sizes instanced in the present application, to hang paper on glass by its corners instead of sticking sheets on a flat display panel, with his first aim of flattening them – but he would surely have recognised it as a different technique, a different product and sought to patent it as a separate invention. Most critically, he would not have been proposing a single layer product, as is the present application.

Claims 13-17 are patentable over Su, it is contended, as:

- Claim 13 relates to the entire structure of the invented tool, described in claims 1 and 10, being of PVC. Su's plate comprises, as noted, of a duplex laminated structure, based on a hard polyethylene plate.
- Claims 14-17 are allowed, it is submitted, as they refer to the two issues, discussed above, of the sizes and the plurality of the two inventions. That is, Su does not refer to, or claim any dimensions for his plate but refers to sheets being adhered to it and so the preferred dimensions instanced in the present application would be outwith the scope and spirit of his invention. Su's product will not work if the assembly is smaller than the sheet.

Claims 19, 24-29 and 31-41 are patentable over Su, in the view of the applicant, because there has been established a sufficiently large amount of evidence that, outside of the use of similar raw materials, there is no similarity between the two inventions in structure or intention or method, while in addition, these above claims have been established as not standing alone and claiming any rights over the mentioned well-known aspects such as plasticisers technology (or preferred sizes) but merely cited as dependencies of the main claims to which they refer.

**Item 10****Rejection of Claims 11-12, 18 and 30**

as unpatentable over Su in view of GB 1.005.155

It is readily agreed by the applicant that the composition and properties of PVC softened with plasticisers are well-known.

Again, the above claims in the present application do not seek to claim any of the prior art in this context. Rather, these claims – and others - are patentable by virtue of their dependencies from claim 1 and refer to the main claim, simply further defining, as they do, the invention in some way as to its material, preferred sizes, gauge etc.

**Conclusion**

The applicant respectfully requests that the Examiner withdraw his rejection of claims 1-10, 11-12, 13-17, 18, 19, 24-29, 30 and 31-41 in view of the applicants remarks herein and issue an allowance for these claims.

If the examiner believes that a phone interview would be helpful, he is respectfully requested to contact the applicant, John MacAlister at + 44 1728 668 204, which may be done at any hour convenient to the Examiner.

Dated 7th July 2004

Respectfully submitted by:



John MacAlister (applicant)

Clockhouse,

Rookery Park,

Yoxford,

Suffolk IP17 3HQ

United Kingdom

tel : + 44 1728 668 204

fax : + 44 1728 668 664

e-mail : patent@macalister.co.uk